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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/020,691	12/14/2001	John Meyer	DEI 00.01 CIP	3392
27667 7590 02/22/2008 HAYES SOLOWAY P.C. 3450 E. SUNRISE DRIVE, SUITE 140 TUCSON, AZ 85718			EXAMINER APPLE, KIRSTEN SACHWITZ	
			ART UNIT 3694	PAPER NUMBER
			MAIL DATE 02/22/2008	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/020,691

Applicant(s)

MEYER, JOHN

Examiner

Kirsten S. Apple

Art Unit

3693

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 22 August 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 77-121 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 77-121 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 5/4/07.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

## **Detailed Action**

This action is in response to the Remarks filed on 08/22/07.

### ***Election***

Claims 77-133 are pending. Claims 77-121 are elected for examination. Claims 122-133 has been restricted with traverse from the applicant. Claims 77-121 are examined.

The applicant argued the restriction was improper because it was not an undue burden to the examiner to search.

The examiner refutes this argument and the restriction requirement remains. In particular in this art unit 3694 which is part of class 705 Business Methods the Federal Register June 5, 2001 (Volume 66, Number 108, Page 30167-30176) noted "The United States Patent and Trademark Office (USPTO) is providing notification to the public of required and optional search criteria used during examination of patent applications related to computer-implemented Business Methods in Class 705."

Restriction for examination purposes as indicated is proper because all these inventions listed in this action are independent or distinct for the reasons given above and there would be a serious search and examination burden if restriction were not required because one or more of the following reasons apply:

- (c) the inventions require a different field of search (for example, searching different classes/subclasses or electronic resources, or employing different search queries);

### ***Priority***

Acknowledgment is made of applicant's claim for prior continuation-in-part of the prior of Application No. 09/737-011, filed 12/14/2000.

***Claim Objections***

Claims 86 -90 & 101-105 & 116-121 are objected to because of the following informalities:

1) The claims 86 -90 & 101-105 & 116-120 contain "said biller & said customer" however the independent claims do not contain a biller or customer. The examiner believes these were used for:

Biller = payee

Customer = payor

Please make the appropriate changes for consistence.

2) Claim 101 should depend on claim 107 not 10.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 77-121 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sandru (U.S. Patent 6,233,340) in view of Kitchen (U.S. Patent 6,289,322) in further view of Mold (U.S. Patent 5,978,772)

**Re claim 77, 92 & 107:** Sandru discloses:

*A bill payment system, method & network, comprising:*

*comprising a unique bar code (see Sandru, Figure 1C, item 110 also see Kitchen, Figure 13, "confirm #", item 1330)*

*bar code comprising data identifier for customer and biller (see Sandru, column 3, line 12-13 "preselected information pertaining to the check" it is inherent that this includes customer and biller as these are two items pertaining to the check.)*

*without additional information embodies an algorithmic signature identifying bar code being proprietary to bill payment system (see Sandru, column 3, line 15-20 "encrypted information" and line 20-35 "secret key" is identical to "proprietary")*

*A Scanning Apparatus in communication with bill payment system (see Sandru, Figure 1A, item 16 & 18)*

*Configured to permit cashier to scan bar code*

*Capable (based on ID data and payment data ) initiating transmission of transfer of fund to an account corresponding to bill in predetermined amount and simultaneously initiating transfer of payment data to a computer of the biller (see Sandru, Column 1, line 17-20)*

*Although Sandru does not have generating an invoice, Kitchen claims generating an invoice for a customer (see Kitchen, Figure 13, for example "Lakewood Racquets Club" is a invoice for the customer – also see abstract for invoice-generating device) , (see Kitchen, column 8, line 68-69)*

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Sandru by adapting *generating an invoice* of Kitchen.

It is clear that one would be motivated to extend the process of money transfer to begin with the invoice and system

Although the combined teaching of Sandru & Kitchen does not Disclose permitting a cashier to scan a bar code, Mold claims *A Scanning Apparatus configured to permit cashier to scan bar code (see abstract)*

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combined teaching of Sandru and Kitchen by adapting *cashier* of Mold.

It is clear that one would be motivated to extend the process to retail stores with cashiers.

**Re claim 78, 93 & 108:** Sandru discloses:

*Funds are transmitted (discussed above)*

Although Sandru does not have *electronic funds transfer*, Kitchen claims "*electronic funds transfer*" (see Kitchen, column 8, line 54-69)

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Sandru by adapting *electronic funds transfer* of Kitchen.

It is clear that one would be motivated to provide alternative transfer options to customer.

**Re claim 79, 94 & 109:** Sandru discloses:

*Funds are transmitted via the Automated Clearing House (Sandru, column 5, line 42-44)*

**Re claim 80, 95 & 110:** Sandru discloses:

*Bar code comprises a plurality of validation levels (see Sandru, Column 3, line 15-20— The examiner is interpreting “levels” as access by different groups and as such Sandra shows a plurality of validation levels with two levels “financial intermediary” or “payor”).*

**Re claim 81, 96 & 111:** Sandru discloses:

*Payment data comprises a date and time customer makes payment or place payment is made (see Sandru, Figure 5 or 6, payment data included on this check clearly states the place payment is made - in this example it was “St. City, MO”. Applicant indicated “or” therefore “date and time” are not necessary.)*

**Re claim 82, 97 & 112:** Sandru discloses:

*scanning system (see Sandru, Figure 1A, “validation system”, item 16, ).*

*Sandru does not have point-of-sale system, Mold claims integrated into a point-of-sale system (see Mold, Figure 1, item 16 & abstract line 1)*

*Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Sandru by adapting point-of-sale system of Mold.*

*It is clear that one would be motivated because to connect to existing systems*

**Re claim 83, 98 & 113:** Sandru discloses:

*Scanning system (see Sandru, Figure 1A, “validation system”, item 16, ).*

*Sandru does not have stores, Mold claims retail store (see Mold, abstract, line 1 a “merchant” is a “retail store”)*

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Sandru by adapting *retail stores* of Mold.

It is clear that one would be motivated because to connect to existing systems

**Re claim 84, 99 & 114:** Sandru discloses:

*Bar code is in a location consisting of: front of invoice, reverse of invoice, detachably printed on invoice, separate piece of paper (see Sandru, column 5, line 23 "negotiable document" is identical to piece of paper)*

**Re claim 85, 100 & 115:** Sandru discloses:

*Data identifying biller (discussed in claims 77, 92 & 107 above).*

Sandru does not specifically teach that the data identifying information is assigned by a central registry authority, Kitchen claims *central registry authority which is connected to the biller* and therefore indicates assigning data identification (see Kitchen, Figure 1, item 100)

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Sandru by adapting *central registry authority* of Kitchen.

It is clear that one would be motivated to simplify the process of fund transactions.

**Re claim 86, 101 & 116:** Sandru discloses:

*Biller transfers bar code to customer by method consisting of:*

*Fax to or from computer, fax machine, email, FTP, HTML, XML, HTTP, modem, Internet, WAN, LAN, diskette and removable storage medium. (see Sandru, column 5, line 30-33, while the prior art does not explicitly state any of these transfer types it is*



*inherent that these would be employed in the statement "as well as any other software the payor may require to interface or integrate" in addition, see Kitchen, Figure 3 & column 3, line 8 "internet")*

**Re claim 87, 102 & 117:** Sandru discloses:

*Access payment information by the payee and/or payor (see Sandru, Figure 1A, Item 16 & 18)*

Although Sandru does not have internet access, Kitchen claims Internet access to biller and/or customer to retrieve payment data info (see Kitchen, abstract, Figure 3 & column 3, line 8, "internet").

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Sandru by adapting internet access of Kitchen.

It is clear that one would be motivated for ease of use through the internet

**Re claim 88, 103 & 118:** Sandru discloses:

*System is adapted to transmit notification to payee of payment (see Sandru, Figure 1A, Item 14)*

Although Sandru does not have email for transmitting notifications, Kitchen claims email or electronic procedure (see Kitchen, Figure 2, Item 100a-d, it is inherent that because this is a network it would be a electronic procedure for the transmitting notification)

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Sandru by adapting email of Kitchen.

It is clear that one would be motivated for ease of use through the email

**Re claim 89, 104 & 119:** Sandru discloses:

*Payment is made by cash, check, debit card or credit card, predetermined amount of funds transmitted to biller is not dependent on payment method (see Sandru, column 5, line 23. "check")*

**Re claim 90, 105 & 120:** Sandru discloses:

*System transmits data to payee (see Sandru, Figure 1A, Item 14)*

Although Sandru does not have transmitting via accounting software, Kitchen claims transmitting data to biller via accounting software (see Kitchen (column 9, line 20-25, and column 6, line 53-55))

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Sandru by adapting accounting software of Kitchen.

It is clear that one would be motivated to connect to existing systems and processes.

**Re claim 91, 106 & 121:** Sandru discloses:

*Scanning apparatus is configured to print a receipt evidencing payment (see Mold, Figure 1, item 52 & abstract last line)*

Sandru has a scanning system (see Sandru, Figure 1A, "validation system", item 16, ) although Sandru does not have printed receipts, Mold claims *Scanning apparatus is configured to print a receipt evidencing payment (see Mold, Figure 1, item 52 & abstract last line)*

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Sandru by adapting printed receipts of Mold.

It is clear that one would be motivated because to provide verification


***Contact Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kirsten S. Apple whose telephone number is 571.272.5588. The examiner can normally be reached on Monday - Friday 9:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 571-272-6712. The fax phone number for the organization where this application or proceeding is assigned is 571-272-6126.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ksa



Kirsten Apple  
Art Unit 3694